UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,853	03/07/2000	Michael O'Doherty	584-1022	8975

23644	7590	08/29/2005

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EXAMINER
LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	09/520,853	O'DOHERTY, MICHAEL
	Examiner	**Art Unit**	
	Victor Lesniewski	2152	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>06 July 2005</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Dung C. Dinh.
Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because: The applicant's arguments are not persuasive. The applicant has argued that there is no suggestion or motivation to combine Handley and Venkatraman and has stated that "There is no suggestion or motivation in Handley to include software code in a SIP message" and "Similarly, there is no suggestion or motivation in Venkatraman to amend POP or SMTP messages to allow storing of software code in those messages." In response, it is noted that the focus of Venkatraman's system is in fact to create a container file that includes executable embedded software to be encrypted in a message. Hence, the combination of Handley and Venkatraman would allow for this type of executable embedded software to be applied with the messages of Handley's system, namely SIP messages, thus meeting the limitations of the claims in question.

The applicant has argued that the systems of Handley and Venkatraman are incompatible since they utilize different protocols. However, it is noted that both systems deal with network communications and one of ordinary skill in the art would have knowledge of a variety of network protocols. Further, both systems are focused on the transfer of multimedia content from one user to another. See Venkatraman, Abstract, and section 3, paragraph 2 of the final action mailed 5/6/2005. Thus, it is maintained that the concepts of the two systems could be reasonably combined.

The applicant has argued that the combination of Handley and Venkatraman does not disclose storing of software in a protocol message. However, Venkatraman clearly states that executable software is embedded into the structure of an email message. Thus, it is clear that Venkatraman supports storing software code in a protocol message. Further, it is noted that this storing step is not a limitation of all of the independent claims.

The applicant has argued that Venkatraman teaches away from the invention since SIP protocol messages are invisible to an end user. Again the applicant is reminded that the rejection is based on the combination of Handley and Venkatraman which incorporates Venkatraman's executable embedded software and the SIP system of Handley. Furthermore, the applicant has supported this argument by stating that an email message (as used in Venkatraman's system) is "a human-to-human message and not a machine-to-machine message." However, it is maintained that email is accepted in the art as being passed from computer to computer or machine to machine. In terms of SIP messages being invisible to an end user, it is again noted that these messages can be used with Internet multimedia conferences and other multimedia distribution. Thus SIP messages, whether or not they are invisible to an end user, are concerned with the transfer of multimedia from one user to another, just as Venkatraman's system

Claims 1-33 remain rejected as presented in the final action mailed 5/6/2005.